

U.S. Application Serial No. 09/843,415
Reply to Office Action of August 24, 2006

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PATENT
450100-03183

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of this application are respectfully requested in view of the remarks and arguments herein, which place the application into condition for allowance. The present response is being submitted to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 3, 5-9, 11-12, 14-18, and 20 are currently pending. Claims 3, 8, 12 and 17 are independent. No claims are being amended. No new matter has been introduced.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 3 and 12 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 5,991,503 to Miyasaka et al. (hereinafter, merely "Miyasaka") in view of U.S. Patent No. 5,010,546 to Kato (hereinafter, merely "Kato").

Claims 3, 6-8, 11-12, 15-17, and 20 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,628,890 to Yamamoto et al. (hereinafter, merely "Yamamoto") in view of Kato.

Claims 5 and 14 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Miyasaka in view of Kato and further in view of U.S. Patent No. 6,865,747 to Mercier (hereinafter, merely "Mercier").

Claims 6-7 and 15-16 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Miyasaka in view of Kato and further in view of U.S. Patent No. 6,002,834 to Hirabayashi (hereinafter, merely "Hirabayashi").

U.S. Application Serial No. 09/843,415
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Claims 5, 9, 14 and 18 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Yamamoto in view of Kato and further in view of Mercier.

As understood by Applicants, Miyasaka relates to an encoding unit which encodes and compresses picture data in a bit map format corresponding to the MPEG method. A packet assembling portion assembles the picture data encoded by the encoding unit as packets in the format corresponding to the MPEG method, and stores the packets to a storing medium. The packet assembling portion writes an I picture index to a packet that contains at least a part of I picture data. When a special reproducing operation is performed, a data storing unit reads only packets that have the I picture index. A decoding unit decodes only I picture data of picture data contained in packets read from the storing medium and displays the decoded picture data.

As understood by Applicants, Kato relates to a packet switching system which has at least first and second packet level control devices and first and second frame level control devices. When a data packet is received at the first frame level control device via a communication line which is connected thereto, the first frame level control device disassembles the data packet and transfers only a header portion of the data packet to the first packet level control device, thereby a data portion of the data packet being transferred directly to the second frame level control device. The second frame level control device assembles the data portion received from the first frame level control device and the corresponding header portion received via the first and second packet level control devices, and transmits the assembled data packet on a communication line which is connected to the second frame level control device.

As understood by Applicants, Yamamoto relates to an apparatus for recording/reproducing image data according to MPEG2 system which obtains I picture data reliably and performs trick playback smoothly. In the apparatus, a PES packet including an I

U.S. Application Serial No. 09/843,415
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PATENT
450100-03183

picture is detected from video coded data which is recorded on a recording medium by an I picture detection unit, an index file of the number of bytes from the start of recording or packet length and the like is created for the PES packet including the I picture data by a index file creation block, and the index file is recorded on an A/V-HDD. In the trick playback process, a navigation control block obtains the index file, and then obtains the I picture data from the PES packet on the basis of the index file, thereby to perform the trick playback smoothly.

As understood by Applicants, Mercier relates to an apparatus and method for storing and playing high definition content. Mercier provides a mechanism for storing and playing back high definition content on a medium such as DVD optical disc. Elementary streams may be multiplexed and processed in a high definition media player instead of at authoring time. Extended real-time features are also provided, such as inserting watermarks into the content stream, decrypting selected sections of the content stream, and performing trick playback display modes.

As understood by Applicants, Hirabayashi relates to an optical disk recording of compressed moving picture data and an optical disk reproduction apparatus each capable of easily effecting trick play such as high speed reproduction and a retrieval operation at a high speed. Additional information necessary for trick play is recorded in an arbitrary area of an optical disk such as a TOC (Table of Contents) or a leading sector (sector 0) of the disk, and a sector address is added to each sector. To conduct trick play, an I picture, a P picture and a B picture contained in a GOP layer inside a bit stream of compressed image data are extracted and reproduced in accordance with a reproduction speed by looking up a trick play table.

Applicants respectfully submit that the present claims are patentable over the applied references for at least the following reasons.

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A. Cited references do not teach all claim recitations

Claim 3 recites, *inter alia*:

"... wherein the first marker packet and the second marker packet include unique packet identifiers not otherwise used in transport stream packets in the received stream."

(Emphasis added)

Applicants respectfully submit that nothing has been found in the cited references, taken alone or in combination, which would teach or suggest the above-identified features of claim 1. Specifically, the cited references, taken alone or in combination, fail to disclose or suggest, that the first marker packet and the second marker packet include unique packet identifiers not otherwise used in transport stream packets in the received stream, as recited in claim 3.

The Office Action concedes that Miyasaka fails to provide a teaching of this feature. Instead, the Office Action relies on Figure 5 and column 7 (line 59) to column 8 (line 11) of Kato for a teaching of this recitation. The Office Action apparently suggests that the first flag F and the second flag F of Kato correspond to the first and second marker packets of the present invention. However, claim 3 recites that the first and second marker packets each have unique packet identifiers. But, Kato does not disclose or suggest that the first flag F and the second flag F have unique packet identifiers. In fact, Kato suggests the exact opposite, that first flag F and second flag F are identical flags, and hence cannot have unique packet identifiers. Hence, Kato fails to meet the recitation that the first and second marker packet have a unique packet identifier, as recited in claim 3.

The other cited references are relied upon solely to meet various limitations in the dependent claims. Applicants respectfully submit that none of the cited references teach or

U.S. Application Serial No. 09/843,415
Reply to Office Action of August 24, 2006

PATENT
450100-03183

suggest that the first marker packet and the second marker packet include unique packet identifiers not otherwise used in transport stream packets in the received stream, as recited in claim 3.

B. No motivation or suggestion to combine cited references

Applicants respectfully submit that there is no motivation, suggested or implied, within the cited references, or within the knowledge of one of ordinary skill, to combine the reference teachings to make the claimed invention. MPEP §2145(X)(c) states:

As discussed in MPEP §2143.01, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references, as discussed in the aforementioned section. (Emphasis added)

Applicants respectfully submit that there is no motivation or suggestion in the cited references to include the first marker packet and the second marker packet include unique packet identifiers not otherwise used in transport stream packets in the received stream, as recited in claim 3. The Office Action has failed to provide a credible motivation to combine the reference teachings, as the motivation suggested on page 4 of the Office Action appears gleaned from Applicants' own disclosure.

C. Impermissible hindsight reasoning and mosaic reconstruction

Applicants respectfully submit that *impermissible hindsight* reconstruction of the claimed invention using elements of the prior art is *not* allowed under 35 U.S.C. §103 (see MPEP §2142 for a discussion of impermissible hindsight).

U.S. Application Serial No. 09/843,415
Reply to Office Action of August 24, 2006

PATENT
450100-03183

Furthermore, MPEP §2143.01(III) states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Emphasis in original.)

Applicants respectfully submit that the Office Action has merely created a mosaic of features from the prior art, without either a clear motivation or a suggestion of the desirability of the combination.

Additionally, MPEP §2143.01(IV) states:

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). (Emphasis added)

As noted above, the Office Action has merely provided references to teach individual aspects of the claimed invention in total isolation, and has not established a *prima facie* case of obvious. The Office Action has failed to provide an objective reason to *combine* the disparate and unrelated teachings of the references into the claimed combination.

Therefore, for all the reasons stated above, Applicants respectfully submit that independent claim 3 is patentable.

For reasons similar to, or somewhat similar to, those described above with regard to independent claim 3, independent claims 8, 12, and 17 are also patentable.

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450100-03183****III. DEPENDENT CLAIMS**

The other claims are each dependent from one of the independent claims, discussed above, and are therefore patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are in condition for allowance and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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